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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/493,741	01/28/00	LEBL	M A-68851-1/DJ

HM22/0315  
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EXAMINER

MOHAMED, A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 03/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/493,741

Applicant(s)

LEBL

Examiner

MOHAMED

Group Art Unit

1653

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 DAYS MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status For restriction purpose only

☒ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-32 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-32 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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### **ELECTION/RESTRICTION**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a method for synthesizing organic compound, classified in class 532, subclass 1+.
- II. Claims 17-26, drawn to a method for separating a liquid, classified in class 530, subclass 412.
- III. Claims 27-32, drawn to an apparatus comprising a centrifuge and a computer, classified in class 435, subclass 283.1+.

The inventions are distinct, each from the other because:

Groups I and II, the methods as grouped are independent and distinct, each from the other because they represent different inventive endeavors. The method of solid synthesis of Group I (claims 1-16) can be used in synthesis of peptides or nucleic acids ; the method of separating a liquid of Group II (claims 17-26) can be used in separating or removing or purifying a biological material by centrifugation. Thus, the methods of Groups I and II are independent and distinct inventions which differ in material makeup and composition requiring different reaction conditions. Hence, Groups I and II differ in method steps, parameters and purposes used, and as such, one does not require the other for ultimate use and is capable of separate manufacture, use and sale, and is novel and patentable over each other.

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Inventions I or II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as the use of a manual centrifuge without a sensor or a computer for separating layers of immiscible or partially miscible liquids.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the searches for the individual groups are not coextensive, restriction for examination purposes as indicated is proper.

If Applicant elects Group I (a method for synthesizing organic compound), claims 1 and 10 are generic to a plurality of disclosed patentably distinct species comprising the following species:

Species I, wherein the organic compound is a polymer of amino acids (peptides) as claimed in claims 3 and 15, classified in class 530, subclass 333.

Species II, wherein the organic compound is a polymer of nucleic acids (nucleoside) as claimed in claims 4 and 16, classified in class 435, subclass 91.1+.

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If Applicant elects Species I, (i.e., synthesis of peptides of claims 3 and 15), then claims 1-2 and 5-14 will be examined along the elected Species I. If Applicant elects Species II, (i.e., synthesis of nucleoside of claims 4 and 16), then claims 1-2 and 5-14 will be examined along the elected Species II. Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species, and to list all claims readable thereon including those subsequently added.

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 3084242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

*Christopher S. F. Low*

CHRISTOPHER S. F. LOW  
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March 14, 2001